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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,126	03/02/2004	Erich Bayer	249971US6CONT	1132
22850	7590	05/15/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PENDLETON, DIONNE	
			ART UNIT	PAPER NUMBER
			2615	

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,126

Applicant(s)

BAYER, ERICH

Examiner

Dionne H. Pendleton

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 17-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "second shank" of **claim 14** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claims 9-16** are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over **claims 15-31 of**

copending Application No. 10/960748 and over **claims 1-14 of copending**

Application No. 10/030192. Although the conflicting claims are not identical, they are

not patentably distinct from each other because of obvious wording variations. For

example, in the immediate application, claim 9 recites “a shank adapted to follow the outer edge of the patient’s cavum conchae”, whereas claim 1 of Application No.

10/030,192 recites “a clip, which follows the outer edge (36) of the cavum conchae(22)”

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims **9 and 11-15** are rejected under 35 U.S.C. 102(b) as being anticipated by **W.C. Jones (1,668,910)**.

Regarding claim 9, Jones teaches in **figure 1 and figure 2**, an earpiece for behind-the-ear parts of hearing acoustics devices, comprising: a shank **11** adapted to follow an outer edge of a patient's cavum conchae;

and upper angled segment, shown but not labeled in figure 1, which lies in the area of the *crura of the antihelix* and which is connected to the shank **11**, wherein this angled segment reads on “an angled traverse segment” connected with the shank and disposed above the antitragus and extending in a direction of the porus acusticus externus;

in **figure 3**, Jones teaches “a broadened portion” **20** which is in connection with and therefore “disposed on” the angled traverse segment, said broadened portion defining a bore **15** configured to hold a signal conductor **12**, which appears in figure 1 to be held in the upper half of the patients auditory canal such that the signal conductor **12** does not cover the lower half of the patients auditory canal, as claimed.

Regarding claims 11 and 13, figure 4 of Jones teaches that the broadened portion **20** includes an auditory canal tab **13** which appears to be disposed in the upper region of the auditory canal and further wherein the canal tab **13** has a diameter which is less than the diameter of the patients auditory canal, thereby facilitating insertion thereto.

Regarding claim 12, as disclosed in the rejection of claim 9, above, Jones teaches a shank **11**, angled traverse segment (*shown but not labeled*) disposed above the anti-tragus, a broadened portion **20** which holds a signal conductor **12** in the upper half of the patients auditory canal, an auditory canal tab **13** which appears to be disposed in the upper region of the auditory canal and a bore (*shown at the terminal end of the canal tab*) for holding signal conductor **12**.

Regarding claim 14, in **figure 1**, Jones appears to teach that the shank **11** comprises a second shank portion connecting with upper angled portion, which reads on "the angled traverse segment" and extending in an opposite direction to the shank, the second shank configured to follow the outer edge **16** of the patient's cavum conchae.

Regarding claim 15, figure 1 teaches that the second shank is adapted to extend to a location behind the patient's antitragus.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over **W.C. Jones (1,668,910)**.

Regarding claim 10, Jones does not clearly teach that the broadened portion **20** of figure 3, comprises a *flexible* signal conductor.

However, it would have been obvious for one of ordinary skill in the art at the time of the invention to construct the ear insert portion **10,13,14** from a flexible material, such that the signal conductor **12** mounted therein is also flexible, thus allowing the device to be comfortably accommodated within ear canals of varying dimensions.

6. **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over **W.C. Jones (1,668,910)** in view of **Boesen (US 6,094,492)**.

Regarding claim 16, Jones teaches an earpiece for use in connection with an auxiliary device. Jones does not clearly teach that the auxiliary device is a cochlear implant microphone, CI BTE processor and BTE tinnitus system.

Boesen teaches, in **column 2, line 53- column 3, lines 26**, and earpiece may be constructed for connection to the angled traverse segment, and the broadened portion is adapted for use with any variety of devices not excluding a cochlear implant microphone, CI BTE processor and BTE tinnitus system.

It would have been obvious for one of ordinary skill in the art to alter the earpiece of Jones such that it is useable with any of a cochlear implant microphone, CI BTE

processor and BTE tinnitus system, for the purpose of transmitting voice signals to the wearer.

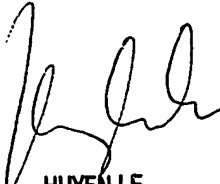
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne H. Pendleton whose telephone number is 571-272-7497. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dionne Pendleton


HUYEN LE
PRIMARY EXAMINER